

Remarks

Claims 1-65 are pending in the Application.

Claims 1-35 are withdrawn from consideration.

Claims 36-65 are rejected.

Claim 60 is objected to.

Claims 1-35 and Claim 60 are cancelled herein.

Claim 61 is amended herein.

I. RESTRICTION UNDER 35 U.S.C. § 121

Examiner has restricted Claims into two Groups: Claims 1-35 (Group I) and Claims 36-65 (Group II). Office Action, at 2. Applicant confirms their election, without traverse, of Claims 36-65 belonging to Group II. Claims 1-35 have been cancelled herein without prejudice.

II. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

The Examiner has provisionally rejected Claims 36-38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 44-46 of commonly owned and copending United States Patent Application Serial No. 09/935,994 ("the '994 Patent Application"). Office Action, at 3.

The Examiner has also provisionally rejected Claims 36-38 and 65 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 27, 28, 58, 59 and 65 of the '994 Patent Application. Office Action at 4.

The Examiner has also provisionally rejected Claims 39-41, 44-51, 53-59, 63 and 64 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 44-46, 51, 53, 55, 58, 59, 62, 63, 65 and 66 of the '994 Patent Application. *Id.*

Applicant respectfully traverses these rejections. However, to facilitate prosecution of the Application, Applicant hereby responds with the enclosed Terminal Disclaimer to moot these provisional rejections.

III. CLAIM “OBJECTED TO”

The Examiner has objected to Claim 60 under 37 U.S.C. § 1.75 as being a substantial duplicate of Claim 61. Office Action, at 5.

To facilitate prosecution of the claims, Applicant hereby cancels Claim 60.

IV. CLAIM REJECTION UNDER 35 U.S.C. § 112

The Examiner has rejected Claim 61 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Office Action, at 5. Examiner contends “It is unclear whether the second polymer coats the same aggregate or a aggregate different from the aggregate that is coated by the first polymer. If it’s the former, then it’s unclear how two polymers can be wrapped on the same aggregate. Are they superposed each other?” Office Action, at 5-6.

Applicant respectfully traverses the rejection and submits that more than one polymer can coat the same aggregate, *i.e.*, one polymer can coat a first portion of the aggregate of the uncoated single-wall carbon nanotubes and another polymer can coat a second portion of the aggregate of the uncoated single-wall carbon nanotube. For example, see Figure 2A in the Application and observe how wrapping of several different polymers can be manifested in the case of a single-wall carbon nanotube. In Figure 2A, the coating or wrapping on a single-wall carbon nanotube is a double helix. One strand of polymer could be a first polymer and the other could be a second polymer. Likewise, Figure 2B shows a triple helix wrapping scheme. In this case, three different polymer strands could be wrapping or coating a nanotube. Such wrapping schemes also apply to coating bundles of single-wall carbon nanotubes.

To clarify, Applicant has herein amended the wording of Claim 61 as follows:

61. A composition of matter in accordance with claim 45, wherein a first polymer that coats a first portion of the aggregate of the uncoated single-wall carbon nanotubes is cross-linked with a second polymer that coats a second portion of the aggregate of the uncoated single-wall carbon nanotubes.

In light of the foregoing, Applicant respectfully requests the Examiner withdraw the rejection of Claim 61 under 35 U.S.C. § 112 as being indefinite.

V. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b) AS BEING ANTICIPATED BY STAR

Examiner has rejected Claims 36-59 and 63-65 under 35 U.S.C. § 102(b) as anticipated by *Star et al.*, "Preparation and Properties of Polymer-Wrapped Single-Wall Carbon Nanotubes" *Angew. Chem. Int. Ed.* **2001**, 40, No. 9, pp. 1721-1725 ("*Star*"). Office Action, at 6.

With all due respect, *Star* is not prior art for the claims of the present Application. *Star* was published online on May 4, 2001. See Exhibit A attached hereto. The present Application claims priority to provisional United States Patent Applications Serial Number 60/227,604, filed on August 24, 2000 ("the '604 Patent Application"), and Serial Number 60/268,269, filed on February 13, 2001 ("the '269 Patent Application").

Each of Claims 36-59 and 63-65 of the present Application are supported by at least the '269 Patent Application; thus, such supported pending claims of the Application have an effective filing date of at least February 13, 2001. See M.P.E.P. § 706.02. Accordingly, *Star* is not prior art to the rejected claims.

In light of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejection of Claims 36-59 and 63-65 under 35 U.S.C. § 102(b) as anticipated by *Star*.

VI. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a) OVER CONVENTIONAL NANOTUBE/POLYMER COMPOSITES IN THE ART IN VIEW OF STAR

Examiner has rejected Claims 60-62 under 35 U.S.C. § 103(a) as being unpatentable over conventional nanotube/polymer composites known in the art in view of *Star*." Office Action, at 7.

For the same reasons as noted above, *Star* is not prior art for Claims 60-62 of this Application. Again, *Star* was published online on May 4, 2001. Each of Claims 60-62 of the present Application are supported by at least the '269 Patent Application; thus, such supported pending claims of the Application have an effective filing date of at least February 13, 2001. Accordingly, *Star* is not prior art to the rejected claims.

In light of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejection of Claims 60-62 under 35 U.S.C. § 103(a) as being unpatentable over conventional nanotube/polymer composites known in the art in view of *Star*.

VII. CONCLUSION

As a result of the foregoing, it is asserted by Applicant that the Claims in the Application are now in a condition for allowance, and respectfully requests allowance of such Claims.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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